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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/348,816	07/08/1999	TAKASHI KOBAYASHI	018773-022	5787

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EXAMINER

ATKINSON, CHRISTOPHER MARK

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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15

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR REPLY:

- a) ☐ will expire three months from the date of the final Office action (including extensions of time granted).
- b) ☐ expires either (1) three months from the mail date of the final Office action, or (2) on the mail date of this Advisory Action, whichever is later. In no event, however, will the statutory period for reply expire later than six months from the mail date of the final Office action.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above.

- ☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's reply to the final rejection, filed 12/9/02 has been considered with the following effect, but it is not deemed to place the application in condition for allowance.

1. ☒ The proposed amendment to the claim and/or specifications will not be entered and the final rejection stands because:

- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The proposed amendments raise new issues that would require further consideration and/or search.

2. ☐ Newly proposed or amended claim _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claim allowed: 27 + 29

Claims objected to: none

Claims rejected: 2, 6-7, 15-16, 26, 28 + 30-31

However;

- ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because _____

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other _____

Applicant may obtain further examination by filing a request for an application under 37 CFR 1.53(d) (CPA).

CHRISTOPHER ATKINSON
PRIMARY EXAMINER

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Response to Amendment

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claims 4-5, 9-14 and 18-25 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7. Claims 9 and 18 were not found in the description of the embodiment of Figure 1 (i.e. the elected species).

Claim Rejections - 35 USC § 112

Claims 6-7, 15-16, 28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "the evaporator" in claims 6, 15, 28 and 30 are indefinite since more than one evaporator has previously been recited and it is unclear which evaporator applicant is referencing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 and 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by ^{ca}gushi et al. See at least figure 9.

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Claims 6-7, 15-16 and 31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Moore, Jr. The patent of Moore, Jr. in figure 18 discloses applicant's claimed invention. Item 236 is read as a reservoir since it contains liquid.

Allowable Subject Matter

Claims 27 and 29 are allowed.

Claims 28 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's concerns directed toward Moore, Jr. are not found persuasive. See figure 18 in Moore, Jr. where reservoir (236) is connected to liquid+ vapor ejection port/outlet (bottom conduit/line from evaporator 230). Stated in *Ex parte Masham*, "a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed." It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

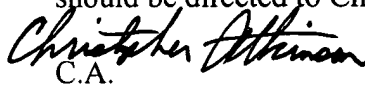
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action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Atkinson whose telephone number is (703) 308-2603.


C.A.

September 18, 2002

CHRISTOPHER ATKINSON
PRIMARY EXAMINER